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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,052	10/23/2003	Yi-Chung Chan	320528643US	1566
25996	7590	01/29/2010		
PERKINS COIE LLP			EXAMINER	
PATENT-SEA			BIBBINS, LATANYA	
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SEATTLE, WA 98111-1247				
			ART UNIT	PAPER NUMBER
			2627	
			NOTIFICATION DATE	DELIVERY MODE
			01/29/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

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# Office Action Summary

**Application No.**

10/693,052

**Applicant(s)**

CHAN, YI-CHUNG

**Examiner**

LaTanya Bibbins

**Art Unit**

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-45 is/are allowed.
- 6) ☒ Claim(s) 46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 15, 2009 has been entered.
2. In the amendment filed on October 15, 2009, Applicant amended claim 39. In the remarks filed on October 15, 2009 and January 15, 2010, Applicant submitted arguments for allowability of claims 39-48.

***Response to Arguments***

3. Applicant's arguments, with regard to claims 46-48 filed October 15, 2009 and January 15, 2010 have been fully considered but they are not persuasive.

Applicants arguments filed January 15, 2010 mischaracterizes the arguments presented by the Examiner in the Advisory Action dated December 2, 2009 by stating that "The Examiner also indicated that irrespective of what was known in the art, claims 46-48 would remain rejected because applicant's disclosure does not expressly describe processors/processor-readable media." Applicant further argues that "the correct legal standard for §112 written description is whether the disclosure of the application reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter," that "the subject matter of the claim need not

be described literally in order for the disclosure to satisfy the description requirement " and concludes that the processor-readable storage medium of claims 46-48 is supported by the disclosure because "one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention."

Examiner respectfully disagrees with Applicants mischaracterization of Examiners arguments presented in the Advisory Action dated December 2, 2009 and Applicants argument regarding the legal standard for applying the 35 U.S.C.112, first paragraph rejection. As stated in the Advisory Action, "while processors and processor-readable mediums may be commonly employed in optical devices and optical disk systems, ***optical storage medium discrimination is not inherently performed by a processor-readable medium.*** In addition, ***a processor-readable medium which specifically stores instructions for discriminating a type of optical storage medium is neither disclosed nor described in the original specification.***" Therefore, because a processor-readable medium that performs the claimed functions is not disclosed, the written description requirement is violated.

With regard to the legal standard for applying the 35 U.S.C.112, first paragraph rejection, the first paragraph of 35 U.S.C.112 states that "***the specification shall contain a written description of the invention***, and of the manner and process of making and using it, ***in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same***, and shall set forth the best mode contemplated by the inventor of carrying out his invention." MPEP § 2163.06 states that

"lack of written description is an issue that generally arises with respect to the subject matter of a claim. If an applicant amends or attempts to amend the abstract, specification or drawings of an application, an issue of new matter will arise if the content of the amendment is not described in the application as filed." MPEP § 2163.06 further states that "if new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement."

In this instance in the amendment filed September 15, 2008, Applicant added claims 46-48 which recite "a processor-readable medium storing instructions for discriminating a type of an optical storage medium." While it is recognized that in order to satisfy the written description requirement the subject matter of the claim need not be described literally, an applicant may show possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, and diagrams that fully set forth the claimed invention. The original specification, however, fails to disclose, imply or even suggest a processor-readable medium that is for storing/implementing the instructions for discriminating a type of optical storage medium as recited in claims 46-48. In addition, the claimed optical storage medium discrimination is not inherently performed by a processor-readable medium. Therefore, the processor readable medium of newly added claims 46-48 is not supported by the as-filed disclosure and the written description requirement is violated.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted January 15, 2010 has been considered, however, it is noted that a strike through has been placed on references that have not been considered in the IDS due to failing to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Drawings***

4. The drawings were received on October 15, 2009. These drawings are not acceptable because of noncompliance with 37 CFR 1.121(d).

#### **Replacement Drawing Sheets:**

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. **Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).** A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing

figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

**Timing of Corrections:**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**6. Claims 46-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In the amendment filed September 15, 2008, applicant added claims 46-48 which recite "a processor-readable medium storing instructions for discriminating a type of an optical storage medium." However, the original specification fails to disclose or contain a written description of a processor-readable medium that is for storing/implementing the instructions for discriminating a type of optical storage medium as recited in claims 46-48. Therefore, the processor readable medium of newly added claims 46-48 is not supported by the as-filed disclosure and the written description requirement is violated.

***Allowable Subject Matter***

**7. Claims 29-45 are allowed.**

**8. The following is an examiner's statement of reasons for allowance:**

Claims 29-45 are allowed for the reasons indicated in the previous Office Action.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."



**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaTanya Bibbins whose telephone number is (571)270-1125. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LaTanya Bibbins/  
Examiner, Art Unit 2627

/Wayne Young/  
Supervisory Patent Examiner, Art Unit 2627